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| 09/993,794      | 11/23/2001  | John Phillip Chevalier | SOMMR-006CUS        | 1594             |

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EXAMINER

ESTREMSKY, GARY WAYNE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3677

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/993,794

Applicant(s)  
Chevalier

Examiner  
Estremsky

Art Unit  
3677



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 138-147 is/are pending in the application.
- 4a) Of the above, claim(s) 140 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 138, 139, and 141-147 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on May 8, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Drawings***

1. The corrected or substitute drawings were received on May 8, 2003. These drawings are approved.

### ***Election Requirement***

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Group I - motor vehicle latch with rotatable actuator as best shown in Fig 1 for example. Claims 139 and 147 appear to be exclusively drawn to the rotatable embodiment.

- b. Group II - motor vehicle latch with linear actuator mechanism as best shown in Fig 5 for example. Claim 140 appears to be exclusively drawn to the linear embodiment.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 138 and 142-146 appear to be generic.

3. Newly submitted claim 140 is directed to an invention that is distinct from the invention originally claimed for the following reasons: the prior art is extensive as regards the more general features of the invention and the actual physical differences between linearly-operable and

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rotatably-operable mechanisms is such that the fact that a prior art reference teaches one or the other (of linear and rotatable) arrangement does not make the other arrangement 'obvious'. The inventions are patentably distinct.

The independent and distinct searches and consideration of exclusive details specific to both embodiments would place undue burden on the examiner. Regardless, generic claims will be examined and if found allowable, claims to the other embodiment that are dependent therefrom can be rejoined thereby avoiding undue hardship for Applicant.

Since applicant has received an action on the merits for the originally presented rotational-operable embodiment of the invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 140 is withdrawn from consideration at this time as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

If claims are added by amendment, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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***Claim Objections***

4. Claim 138 is objected to because of the following informalities:

- a. Claim 138; line 4 - "an" should be replaced with --and--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 144-147 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Inasmuch as the claimed invention does not positively recite the "striker" as part of the invention, it is not clear if, or in what way, the present functional language regarding use with a striker further defines the structure that is claimed as the invention.

Examiner notes that one of ordinary skill in the art interprets 'latching' of a motor vehicle lock mechanism to describe the ratchet-like engagement between the bolt (in its latched position) and the pawl that prevents counter-rotation of the bolt to the open position until the pawl is released. The latched position of the bolt can occur with or without presence of a striker. However, the examiner also notes that it is well known in the art that the motion of the striker

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into the lock device can be used to move the bolt against its spring bias towards its latched position where it can be engaged by the pawl. In the present case, it is not clear how the motor can cause the striker to enter the lock device or otherwise perform the function as recited in the claim. It is not clear what structure(s) should be included within scope of the invention.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 138, 139, and 141-147 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,386,599 to Chevalier. Although the conflicting claims are not identical, they are not patentably distinct from each other because any differences in scope might only be interpreted as including obvious design variants of the same invention as it has been disclosed.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 138, 139, 141, and 143-147 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,762,348 to Matsumoto.

Matsumoto '348 teaches Applicant's claim limitations for a latch arrangement including : an "electric motor" - 26, a "driving and indexing member coupled to the motor" - 29, "having a single projection" - 30, at "least one actuation member" - 37, a "latch assembly mechanically coupled to the projection" - 11 via parts including 46,54, "means for controlling the electric motor" - including switches SS1,SS2,SS3,SS4, a "latching pawl mechanically coupled to the projection" - 16 is 'mechanically coupled' for 'direct response' via intermediary coupling elements.

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As regards claim 142, the limitation must be interpreted as requiring contact between the latching pawl and projection whereas claim 141 is broad enough to include intermediate various connecting elements as part of the "latch assembly".

As regards claims 144 and 145, the reference describes operation of the lock and particularly movement of the sectoral member 30 with respect to latching and locking positions whereby the present claimed invention has not patentably distinguished from well known structure of the prior art.

As regards claims 144-147, 'as best understood', the latch of the prior art has all of the structures now defined by the present claim. See MPEP 2114. While functional language is not ignored, it must be interpreted in context of how it further defines the structure or arrangement of the claimed product. In the present case, the claimed invention has not patentably distinguished from the prior art product which can function as now recited by the claim.

11. Claims 138, 139, 141, 142, and 144-147 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,411,302 to Shimada.

Shimada '302 teaches Applicant's claim limitations for a latch arrangement including : an "electric motor" - 35, a "driving and indexing member" - including 51 "having a single projection" - 53, at "least one actuation member" - 90, a "latch assembly" - including 60, a "latching pawl mechanically coupled to the projection" - 73a.



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As regards claim 144, the full latched position of the reference device (as contrasted with the latched but partially open position) reads on limitation of “to lock the latch assembly in response to movement of the projection a second distance” inasmuch as the key cylinder must be used to cause unlocking from the full latched position. The structure of the claimed product has not defined from well known structure of the prior art in this relatively crowded technological area.

### ***Response to Arguments***

12. Applicant's arguments filed May 8, 2003 have been fully considered but they are not persuasive.

Applicant's arguments that the claimed invention differentiates from the Matsumoto device due to that reference having “multiple motor driven functions” is not clear. Present claims are anticipated by the device of the reference including a single electric motor (26). It is suggested that persuasive argument point out claim limitations of the present invention that is/are not taught by the prior art. As best understood, the device of Matsumoto has all of the structure now claimed as the invention whereby that structure can function as now broadly recited. Similar consideration applies to arguments against Shimada '302 although it is noted that claim 143 is not rejected in view of that reference. Regardless however, it is suggested that persuasive argument point out structure of the claimed invention that is not taught by the prior art.

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It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The law of anticipation requires that a distinction be made between the invention described or taught by the prior art and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Complete response should respond to all objections and rejections raised in this Office Action.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) \_\_\_\_ - \_\_\_\_ ) on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

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(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

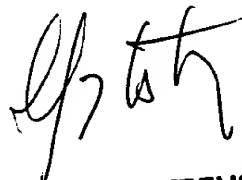
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

July 8, 2003



GARY ESTREMSKY  
PRIMARY EXAMINER